FEB 16 2006

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 10015699-1 (HDP#6215-000060/US)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] On _____ Signature _____ Typed or printed name _____	Application Number 10/043,562	Filed January 11, 2002
	First Named Inventor Mathias POPP et al.	
	Art Unit 2186	Examiner Pierre-Michel BATAILLE

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages of attachments are provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☐ attorney or agent of record.
Registration number. _____

☒ attorney or agent acting under 37 CFR 1.34.
Registration number: 37,275

_____ Signature

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Typed or printed name

703-688-8000
Telephone number

February 16, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Mathias POPP et al.
Application No.:	10/043,562
Filed:	January 11, 2002
Group:	2186
Examiner:	Pierre-Michel BATAILLE
For:	REMOTE MIRRORED DISK PAIR RESYNCHRONIZATION MONITOR
Att'y Docket No.:	10015699-1
	(HD#6215-000060/US)

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Randolph Building
401 Dulany Street
Alexandria, VA 22314
Mail Stop AF

February 16, 2006

ATTACHMENT TO FORM PTO/SB/33 ("PRE-APPEAL BRIEF REQUEST FOR REVIEW")

Sir:

Further to the concurrent filing of the attached Notice of Appeal, the following remarks are submitted in connection with the above-identified patent application under the Pilot Program for Pre-Appeal Brief Conference (Off. Gaz. Patent & Trademark Office, Vol. 1296, No. 2, July 12, 2005).

Claims 1, 4-7, 9-14, 16-18, 20-22 and 24-37 are pending. Of these, claims 1, 18, 22, 31 and 32 are independent. Also, of those, claims 7, 9-10, 12-13 and 16-17 have been indicated as allowable.[1]

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[1] That is, they have received a formal objection because they depend upon one or more rejected claims, respectively, but have not been rejected over art.

Rejection For Which Conference Is Requested

A Pre-Appeal-Brief Conference is requested to review the rejection[2] of claims 1, 4-6, 11, 18, 20-22 and 24-34 under 35 U.S.C. §102(e), as being anticipated by U.S. Pre-Grant Publication (PGPub) 2004/0073831 (the '831 PGPub) to Yanai et al. Appellants traverse this rejection.

Previously[3], Appellants argued that a distinction over the '831 PGPub of claim 1 (taking it as an example) is automatically updating the at least one status field of the machine-actionable memory based upon the requested status information.

The Examiner disagrees. On page 3 of the Final Office Action, he refers to Paragraphs [0348] and [0185] of the '831 PGPub and states (underlined emphasis added): "Simply, it is clear that user intervention is not required, as the remote mirroring status can be programmed for automatic resynchronization by the host application software." Appellant disagrees. In particular, the Examiner's characterization that remote mirroring status "can be" programmed reflects that the '831 PGPub does not represent an anticipatory reference.

The portion of Paragraph [0348] focused upon by the Examiner states (underlined emphasis added):

> [0348] ... The host remote mirroring software commands may be integrated into automated operations or host applications, giving the user a robust and elegant implementation of remote mirroring with a great deal of flexibility and control.

This excerpt indicates that host remote mirroring software commands may be integrated into one of (1) automated operations or (2) host applications. Such commands are not integrated. Rather, they may be integrated. At most, this represents an invitation to experiment. Hence, the Examiner is constrained to state only that remote mirroring status "can be" programmed.

This shortcoming in the Examiner's reasoning possibly could be cured if the Examiner were to explain how the missing claimed feature was inherent to the '831 PGPub.

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[2] See reply by Applicants filed August 29, 2005, specifically page 10 in the context of the traversal presented on pages 9-12.
[3] The statement of rejection spans pages 5-10 of the Final Office (mailed November 16, 2005), with the Examiner's rebuttal arguments spanning pages 2-4 thereof.

Under U.S. patent law[4], an aspect not literally disclosed by a reference is considered to be inherently present if the difference between what is literally disclosed and what is claimed necessarily flows from the literal disclosure. Here, it is unreasonable to assert that the claimed feature, namely, automatically updating the at least one status field of the machine-actionable memory based upon the requested status information, necessarily flows from the above-quoted excerpt of Paragraph [0348] of the '831 PGPub. Nor does it necessarily flow from Paragraph [0030] of the PGPub, which is another Paragraph focused[5] upon by the Examiner. The portion of Paragraph [0030] focused upon by the Examiner states (underlined emphasis added):

> [0030] In accordance with yet another aspect of the invention, there is provided host remote mirroring software for permitting a system operator <u>or host application program</u> to monitor and control remote mirroring, migration, and recovery operations. ...

Such host remote mirror software permits either (1) a system operator or (2) a host application program to monitor, control, etc. Which one enjoys this capability? That is, which of (1) the system operator or (2) the host application program is enabled by the host remote mirror software? If it happens to be the host application, then how is such capability made possible? How is it enabled?

Perhaps the answer is found in Paragraph [0177] focused upon by the Examiner? Paragraph [0177] of the '831 PGPub states:

> [0177] Each secondary (R2) volume has a configurable attribute, "sync required", for selectively preventing a secondary (R2) volume from becoming ready to the remote host if a state change is attempted while it is not synchronized with its primary (R1) volume. If the "sync required" attribute is not enabled, then all specified state changes to the secondary (R2) volume take effect when requested. If the "sync required" attribute is enabled, and if the secondary (R2) volume is not synchronized with the primary (R1) volume and not ready to the remote host at the time of the failure, then the non-synchronized secondary (R2) volume will remain not ready. Regardless of the state

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[4] For example, see the Manual of Patent Examining Procedure, Section 2112 in general, and particularly the subsection entitled "Examiner Must Provide Rationale Tending To Show Inherency".

[5] See page 4 of the Final Office Action.

of the "sync required" attribute, if the secondary (R2) volume were synchronized with the primary (R1) volume and not ready to the remote host at the time of the failure, then the secondary (R2) volume will assume the specified change of state (read-only or read/write enabled).

It is not apparent to Appellants how Paragraph [0177] makes it possible for host remote mirror software to permit a host application program to monitor, control, etc. as touted in Paragraph [0030]. Nor it is reasonable to assert that the claimed feature necessarily flows from Paragraph [0177] of the '831 PGPub.

The Examiner also focuses upon a portion of Paragraph [0024], namely:

[0024] Another aspect of the present invention provides mechanisms for selectively inhibiting automatic or manual recovery when automatic or manual recovery would be inappropriate. ...

Paragraph [0024] characterizes the recovery as automatic or manual. The mechanisms for selectively inhibiting, however, are not characterized as automatic. Such mechanisms, rather than the recovery, are relevant to the claimed feature, namely automatically updating the at least one status field of the machine-actionable memory based upon the requested status information.

Paragraph [0024] is consistent with Appellant's explanation[6] that monitoring has traditionally been done manually by the system operator. As noted in Appellants' Background Section (e.g., lines 35 et sec. at page 2):

Traditionally, the administrator monitors the status of the disk pair as reported by the mirroring software; and thus the monitoring of disk pair status, the detection of any interruption in the mirroring process and repair thereof, or predominantly manual processes.

In other words, the administrator manually queries the disk pair for their respective status. Data indicative of that status is provided to the administrator in response to the query. The manner in which such status data is presented to the administrator is volatile as contrasted with data in a machine-actionable record of a memory. Such status data exists as an output on a display screen.

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[6]   See page 9 of the reply filed August 29, 2005.

Taking the disclosure of the '831 PGPub as a whole, the overwhelming character is that of a manual monitoring system. Appellants have explained this previously[7] in the context of what Paragraphs [0366]-[0566], [0604], [0257]-[0268], [0286] and [0274] actually teach.

In view of the foregoing discussion, Appellants reiterate that a distinction of claim 1 over the '831 PGPub is automatically updating at least one status field of the machine-actionable memory based upon the requested status information. The other rejected claims similarly distinguish over the '831 PGPub.[8]
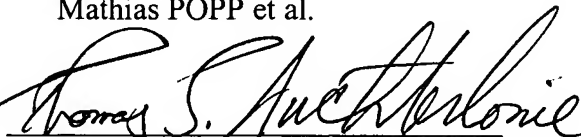
CONCLUSION

In view of the above remarks, Appellant respectfully requests the Pre-Appeal Brief Conference to find in favor of Appellants' positions and arrange for withdrawal of the above-noted rejections, culminating in the sending of a Notice of Allowance of the pending claims.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-2025 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

Mathias POPP et al.

By _____

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[7]   See pages 10-12 of the reply filed August 29, 2005.

[8]   Claims 4-7, 9-14 and 16-17 depend at least indirectly from claim 1 and distinguish over the '831 PGPub at least for the same reasoning, respectively. Independent claims 18, 22, 31 and 32 recite a similar feature to that of claim 1 discussed above, and hence each similarly distinguishes over the '831 PGPub. Claims 20-21, 24-30 and 33-34 depend at least indirectly from claims 18, 22 and 32, and thus distinguish over the '831 PGPub at least for the same reasoning as claims 18, 22 and 32, respectively.